

REMARKS

Claims 3, 6-8, 13, and 16-18 are rejected under 35 U.S.C. § 112, first paragraph.

Claims 1-2, 4, 9, 10, 12, 14, and 19-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Steudle (US 2002/0006119) in view of Virtanen (US 2001/0008521).

Claims 5 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Steudle in view of Virtanen, and further in view of Vayanos (US 2003/0026235).

I. Claim Rejections - § 112

Claims 3, 6-8, 13, and 16-18 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner further asserts that the term “consisting” is not supported by the specification. (*See* Office Action, pages 2 and 3, #3).

“To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.” (*See* MPEP § 2163(I)). However, “[t]he examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. *See Wertheim*, 541 F.2d at 263, 191 USPQ at 97” (*See* MPEP § 2163(II)(b)). Additionally, the “*in haec verba*” is not required to comply with the written description requirement as long as the newly added claim limitations are supported in the specification through express, implicit, or inherent disclosure. (*See* MPEP § 2163(I)(B)).

Claims 3 and 6-8 include alternative expressions, e.g., a Markush group. Because it is improper to use the term “comprising” instead of “consisting of,” claims 3 and 6-8 were amended to replace “comprising” with “consisting of.” (*See* MPEP § 2173.05(h)). Accordingly,

the alternative expressions recited in claims 3 and 6-8 were supported by the specification and the claims, as originally filed. The correction of “comprising” to “consisting of” to comply with the standard patent practice and procedure does not constitute new subject matter. Additionally, the “*in haec verba*” is not required by the MPEP to comply with the written description requirement. Other than in the original claims, the support for claim 3 is found in the specification, for example, on page 8, lines 15-18, claim 6 on page 8, lines 21-22, and claims 7 and 8 on page 8, lines 23-24.

Finally, the Examiner did not present evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. Therefore, an initial burden is not sustained.

At least for these reasons, it is respectfully submitted that claims 3 and 6-8 comply with the written disclosure requirement of 112, first paragraph. Claims 13 and 16-18 comply with the written disclosure requirement of 112, first paragraph, for the similar reasons.

It is, therefore, respectfully requested that this ground of rejection of claims 3, 6-8, 13, and 16-18 be withdrawn.

Further, “[r]egardless of the outcome of that determination [112, 1st paragraph], office personnel must complete the patentability determination under all the relevant statutory provisions of title 35 of the U.S. code. ... The office action should clearly communicate the findings, conclusions, and reasons which support them.” MPEP § 2163(III).

Therefore, regardless of the rejection under section 112, first paragraph, the Examiner should have completed patentability determination under all statutory requirements and clearly communicated findings, conclusions, and their bases. (*See* MPEP § 2163(III)).

However, the Examiner did not perform a patentability determination. Accordingly, Applicants request such patentability determination be performed and also request the Examiner make the next Office Action, if one is forthcoming, *non-final*.

Moreover, the Examiner did not reply to the Applicants arguments submitted in the October 8 response. However, section 707.07(f) of MPEP requires the Examiner to answer the substance of each Applicant’s argument traversing each rejection.

Therefore, Applicant respectfully requests the Examiner address the arguments submitted in the October 8 response, if the rejections are sustained.

II. Claim Rejections - § 103

Claims 1-2, 4, 9, 10, 12, 14, and 19-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Steudle (US 2002/0006119) in view of Virtanen (US 2001/0008521).

Claim 1 recites among other elements: “choosing a compressed mode configuration from a set of reference compressed mode configurations.”

1. Steudle does not teach or suggest choosing a compressed mode configuration from a set of reference compressed mode configurations

Steudle describes the following measurement gap generation methods: puncturing the data being transmitted, halving the spreading factor, or buffering the data being transmitted onto higher protocol layers. (Abstract). These methods are used to generate gaps in different frames. The compressed mode parameters which determine the generation of measurement gaps for various measurements, in addition to the compressed method being used, are signalled to the mobile station. (Paragraphs 41-44).

The Examiner asserts that Steudle recites “selecting the compressed mode from different several alternatives” in paragraph 13. (See Office Action, page 4). However, Steudle recites “selecting the manner of generating a measurement gap from several different alternatives.” (Paragraph 13). Steudle further teaches that the measurement gaps in different time-slots are generated with different gap generation methods. (Paragraph 14). Therefore, the cited portions of Steudle teach selecting a gap generation method. The cited portions of Steudle do not teach or suggest selecting a compressed mode configuration. Nor do the cited portions teach or suggest selecting the compressed mode from a set of reference compressed mode configurations. Absent such support, the Examiner’s reliance on Steudle does not support the rejection.

2. *Virtanen does not teach or suggest two transmission gaps ... overlap, with an overlap length greater than the time necessary to effect a measurement*

Virtanen describes a first embodiment, in which a certain transmission period with three gaps is repeated. (Paragraph 53; Fig.3). In a second embodiment, there are two transmission gaps within a transmission period. The longer transmission gap is overlapping two frames. (Paragraph 54; Fig. 4).

To the extent Virtanen teaches “overlapping,” it is the frames that get overlapped by the transmission gap. To the contrary, claim 1 calls for the transmission gaps to overlap with one another.

Therefore, even a combination of Steudle and Virtanen lacks “for each reference configuration,... TGL is made sufficiently large so that two transmission gaps ... overlap, with an overlap length greater than the time necessary to effect a measurement.”

Because neither Steudle, nor Virtanen, taken singularly or in combination, teaches or suggests at least “choosing a compressed mode configuration from a set of reference compressed mode configurations,...[wherein] for each reference configuration,... TGL is made sufficiently large so that two transmission gaps ... overlap, with an overlap length greater than the time necessary to effect a measurement,” **claim 1 and dependent claims 2, 4, 9, and 20** distinguish patentably and unobviously over Steudle and Virtanen.

Claim 10 recites features similar to, although not necessarily coextensive with, the features argued above with respect to claim 1. Therefore, arguments presented with respect to claim 1 apply with equal force here. For at least substantially analogous exemplary reasons, therefore, **claim 10 and dependent claims 12, 14, 19, and 21** distinguish patentably and unobviously over Steudle and Virtanen, taken singularly or in combination.

Claims 5 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Steudle in view of Virtanen, and further in view of Vayanos (US 2003/0026235).

Claim 5 indirectly depends on claim 1. Applicants have already demonstrated that Steudle and Virtanen do not meet all of the elements of claim 1. Vayanos does not compensate

for the deficiencies of these references. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Therefore, **claim 5** distinguishes patentably and unobviously over Steudle, Virtanen and Vayanos, taken singularly or in combination, at least by virtue of its dependency.

Claim 15 indirectly depends on claim 10. Applicants have already demonstrated that Steudle and Virtanen do not meet all of the elements of claim 10. Vayanos does not compensate for the deficiencies of these references. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Therefore, **claim 15** distinguishes patentably and unobviously over Steudle, Virtanen and Vayanos, taken singularly or in combination, at least by virtue of its dependency.

CONCLUSION

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Marina V. Zalevsky/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Marina V. Zalevsky
Registration No. 53,825

Date: February 24, 2009